

Remarks for the "Response to Non-Final Office Action dated 10/18/06"

[0003] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-36 are presently pending. Claims amended herein are 1, 19, and 31. Claims withdrawn or cancelled herein are none. New claims added herein are none.

Summary of Interview

[0004] Examiner Ahn and SPE Alam graciously talked with me—the undersigned attorney for the Applicant—and Kayla Brant on January 11, 2007. Applicant greatly appreciates the Examiners' willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

[0005] In that discussion, I explained what I viewed as the differences between the cited art and one or more embodiments described in the Application. The Examiners indicated a preliminary acknowledgement of the differences. Applicant amends claims herein in accordance with those acknowledged differences.

Formal Request for an Interview

[0006] If the Office's reply to this communication is anything other than allowance of all pending claims, then Applicant formally requests an interview with the Examiner of this patent application. I encourage the Examiner to contact me—the undersigned attorney for the Applicant—to

schedule a date and time for a telephone interview that is most convenient for both of us.

[0007] Please email me at kasey@leehayes.com. Please copy my assistant Carly Taylor (carly@leehayes.com) as well. While email works great for me, I welcome you to call either of us as well. (509-324-9256 x232)

Claim Objections

[0008] The Office states (Action, p. 2):

Claim Objections

Claims 2 – 9, 13 – 18, 20 – 26, 28 – 30, 32 – 36 are objected to because of the following informalities:

Claims 2 – 9 recite "One or more media as recited in claim 1". Examiner respectfully suggests Applicant to change this to "The one or more media as recited in claim 1".

Claims 13 – 18 recite "One or more media as recited in claim 12". Examiner respectfully suggests Applicant to change this to "The one or more media as recited in claim 12".

Claims 20 – 26 recite "A method as recited in claim 19". Examiner respectfully suggests Applicant to change this to "The method as recited in claim 19".

Claims 28 – 30 recite "One or more media as recited in claim 27". Examiner respectfully suggests Applicant to change this to "The one or more media as recited in claim 27".

Claims 32 – 36 recite "A system as recited in claim 31". Examiner respectfully suggests Applicant to change this to "The system as recited in claim 31".

Claims 8 – 9, 17 – 18, 25 – 26, 29 – 30 recite "digital items". Examiner respectfully suggests Applicant to change this to "the digital items".

Appropriate corrections are required.

[0009] In the telephone conference, I explained why I saw no informality that needed correction. The Examiners indicated that they understood my explanation, but would like for me to express that reasoning fully in a response. The following is that full explanation:

[0010] All of these claims are dependent. Applicant submits that the subject of each dependent claim is a separate claimed invention. Although a dependent claim refers back to a base claim to provide a base definition of the subject, the subject itself is fresh and new.

[0011] For example, if the reader assumes that a hypothetical independent claim 1 defines a subject Z in the preamble, then a claim dependent therefrom may begin in following proper formats:

- 2. A Z as recited in claim 1, wherein...
- 3. A Z in accordance with claim 1, wherein...
- 4. The Z of claim 1, wherein...

Language such as "as recited in claim 1" or "in accordance with claim 1" defines subject Z (of the dependent claims) in a manner that is clear and definite. Applicant submits that use of "the" instead of "a" does not make the claims more clear or more definite.

[0012] The following persuasive references are provided to support Applicant's position. Specifically, they are (1) examples of patents using the same or similar wording; (2) a quote from well-known and highly respected treatise on claim drafting; and (3) a quote from the MPEP

(which specifically refers to multiple dependent claims, but the fundamental basis is the same for singular dependent claims):

(1) Examples of issued patents using the same or similar wording for dependent claims: 5764526; 5734652; 5721781; 5600368; 5551024; 5512921; 5387976; 5974483; 5933838; and 6,006,330.

(2) Faber, Practicing Law Institute (PLI), *Landis on Mechanics of Patent Claim Drafting*, Fourth Edition, §11 (1997) (pp. II-15 in Faber, Rel. #2, 12/98) (emphasis added) on dependent claims states the following:

This is the single dependent claim with which practitioners are most familiar. Examples include:

The shaker of claim 1, wherein...

The shaker according to claim 1, wherein...

A shaker as claimed in claim 1, wherein...

The shaker as in claim 1, in which...

The words used to establish claim dependency in the preamble of the claim are a matter of choice, so long as the dependency of the claim is clearly set forth.

(3) MPEP 608.01(n) "Dependent Claims" (emphasis added) states the following:

A. Acceptable Multiple Dependent Claim Wording

Claim 5. *A gadget according to claims 3 or 4, further comprising ---*

Claim 5. A gadget as in any one of the preceding claims, in which ---

Claim 3. A gadget as in either claim 1 or claim 2, further comprising ---

Claim 4. *A gadget as in claim 2 or 3, further comprising ---*

Claim 16. *A gadget as in claims 1, 7, 12, or 15, further comprising ---*

[0013] Accordingly, as per the dependent claims in question here, Applicant respectfully requests that the objections be withdrawn. If these objections are maintained, Applicant requests further clarification as to why these claims are considered unclear and indefinite.

Substantive Claim Rejections

Claim Rejections under § 102

[0014] The Office rejects all pending claims (1-36) as being anticipated by US Publication No. 2002/0078075 by James C. Colson (hereinafter "Colson").

[0015] In our discussion, the Examiners preliminarily acknowledgement of the differences between the Colson and one or more of the embodiments described in the Application. In particular, Colson does not employ multiple priority tiered groupings of digital items. Rather, it uses priority schemes to sort its entire database of items. Applicant amends claims herein to accentuate those acknowledged differences.

[0016] Furthermore, in our discussion, I explained how I felt that Claims 12 and 27 (as written) differed from Colson. In particular, Colson does not disclose a UI (user-interface) with a “user-configurable priority corresponding to the one or more digital items in the listing.” Rather, Colson displays its “priority schemes” that it uses to determine the priority. See the middle of ¶ 34 of Colson, which says, “...prioritization schemes [are] preferably presented graphically to the user...”

[0017] Please note Fig. 3 in the Application and in particular item 322 and 324 in that illustration of an exemplary UI. The description of Fig. 3 is found in ¶ 51 of the Application. With emphasis added, that paragraph is reproduced below for the benefit of the reader:

[0051] Fig. 3 shows an example of a user-interface (UI) 300 that employs this two tier model. In area 310 of the UI, there is a list of digital items (specifically, music clips here) such as those designated 312. *Area 320 shows the assigned priority tier of some of the digital items. For example, “8 mile” is designated to be part of the will-fit tier 322 while “Christmas” is part of the excluded tier 324.* Using this UI, the user may choose the tier for each digital item in the collection.

[0018] In light of the telephone discussion with the Examiners, the amendments herein, and the reasoning provided above, Applicant respectfully asks the Examiner to withdraw the rejections of these claims.

Dependent Claims

[0019] In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant submits that the Office withdraw the rejection of each dependent claim where its base claim is allowable.

Conclusion

[0020] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the Office is urged to contact the undersigned attorney before issuing a subsequent Action.

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Respectfully Submitted,

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